

Appl. No. 09/897,572
Atty. Docket No. 7949
Amdt. dated November 7, 2003
Reply to Office Action of October 8, 2003
Customer No. 27752

REMARKS

In response to the Restriction Requirement mailed October 8, 2003, Applicants respectfully traverse the restriction and make an election of Group I.

The Office Action states that Claims 1, 18, and 19 disclose a fuel composition comprising an alcohol that is obvious or anticipated by WO 97/38956, or US 5, 849,960, or WO 97/01521. However, the Office Action is silent as to whether the claimed invention of the present application as a whole is anticipated or obviated in view of the references listed.

It is fundamental that in order to anticipate a claim, a reference must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 44 USPQ2d 1429, 1431. The references cited by the Office Action are cited as speaking solely to the alcohol of Claims 1, 18, and 19 and not the entire claimed invention. Therefore, Applicants submit that the rejection of Claims 1, 18, and 19 as being anticipated by WO 97/38956, or US 5, 849,960, or WO 97/01521 is insufficient to restrict the claimed invention of the present application under PCT Rule 13.1, applicable to the present application via 37 CFR §1.475.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983). The references cited by the Office Action are cited as speaking solely to the alcohol of Claims 1, 18, and 19 and not the entire claimed invention. Therefore, Applicants submit that the rejection of Claims 1, 18, and 19, as being obvious in view of WO 97/38956, or US 5, 849,960, or WO 97/01521 is insufficient to restrict the claimed invention of the present application under PCT Rule 13.1, applicable to the present application via 37 CFR §1.475.

Additionally, Applicants object to the characterization that all claims in Group II require the alcohol of b to be produced by a specific three step process and Group III require the alcohol of b to be produced by a specific two step process. Specifically, Applicants object to the characterization of Claims 20 and 23 as being Group III, as there is no limitation on how the composition of Claim 1 is made.

Applicant respectfully elect Group I, Claims 1-17, 26, 29, 32, 35-45, 48, 51, 52, 55, 56, 59-66, 69, and 73.

Applicant expressly reserves the right to file continuation and/or divisional applications directed to the subject matter of the non-elected Group II (Claims 18, 27, 30, 33, 46, 49, 53, 57, 67, and 70) and Group III (Claims 19-25, 28, 31, 34, 47, 50, 54, 58, 68, 71 and 72).

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

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Conclusion

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-17, 26, 29, 32, 35-45, 48, 51, 52, 55, 56, 59-66, 69, and 73.

Respectfully submitted,
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